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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/818,771 03/14/97 MIRASHRAFI

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EXAMINER

NGUYEN, S

ART UNIT

PAPER NUMBER

2664

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/818,771

Applicant(s)

Mirashrafi et al.

Examiner

Steven Nguyen

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 12, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11, 13-25, 29, and 30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 13-25, 29, and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The Affidavit filed on 3/12/2001 under 37 CFR 1.131 is sufficient to overcome the Radziewicz and Gabber references.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claim 19, lines 7, the recitation "it" is vague and indefinite because it's unclear what the recitation "it" is referred to.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-4, 10-11 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Simmons (USP 5974451).

As claim 1, Simmons discloses a bridge server "Fig 4, Ref 404" for receiving a requested information from a client for targeting a network server "Fig 1, Ref 101" and attaching additional content "Fig 4, Ref 407, Advertisement" into a requested information for transmitting to the user "Fig 4, Ref 410); See col 3, lines 47-66 and claim 7.

As claims 2 and 4, Simmons discloses a step of determining if any advertisements are associated with the remote information server, then selecting an advertisement to relay to the user (Fig 4, Ref 407-408); See col 3, lines 47-66 and Claim 7.

As claim 3, Simmons discloses a step of sending an additional content "advertisement" which separates from requested information "Fig 6, Ref 603-604"; See col 3, lines 47-66, claim 7.

As claims 10-11 and 17-18, Simmons discloses a bulletin information comprising hyperlink to identify the additional content information (See col 10, lines 10-24).

As claim 19, Simmons discloses a bridge server "access system of Fig 1" for receiving a request for information of targeted server "Fig 1, Ref 101", determining if any advertisements are associated with the remote information server, then selecting an advertisement to relay to the user (Fig 4, Ref 407-408) and adding the additional information "bulletin information" into requested information to provide to the user; See col 3, lines 47-66 and Claim 7 and 5.

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As claims 20-21, Simmons discloses a bulletin information being mark or tag by hyperlink such as URL to allow the user to retrieve the addition information, See col 10, lines 10-24.

6. Claims 24-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Haserodt (USP 6031836).

As claim 24, Haserodt discloses a bridge server (Fig 1, Ref 104) for receiving a request for content which targets a network server (Fig 1, 105); the bridger server 104 marks up the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for receiving a request for content of a network server 105 from user 113; the server 104 generates a mark up request form for transmitting to the user 113; allowing the user 113 to resubmit the request the marked up content to server 104); See col 3, lines 55 to col 4, lines 60.

As claim 25, Harerodt discloses a bridge server (Fig 2, Ref 104) removing the marked up content after receiving a resubmitted request and forwarding the request to the server (Fig 2, Ref 105, the server removed the requested data from the marked up form and forwards the requested data to the server 105); See col 3, lines 55 to col 4, lines 60.

As claim 29, Haserodt discloses in Fig 2, a client including a control logic for transmitting a request that target the server 105 and retransmitting the marked up request after receiving a mark up form from a bridge server 104; See col 3, lines 55 to col 4, lines 60.

7. Claims 1-4, 10-11 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Hoff (USP 5822539).

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As claim 1, Van Hoff discloses a bridge server "Fig 2, Ref 118" for receiving a requested information from a client for targeting a network server "Fig 2, Ref 104" and attaching additional content "Fig 2, Ref 120 for merging the additional information into the requested information" into a requested information for transmitting to the user "Fig 2, Ref 102".

As claim 2 and 4, Van Hoff discloses a step of determining if any addition contents are associated with the remote information server, then selecting an addition content to relay to the user (Fig 2, Ref 120 for determining if any documents are related to the requested information, if yes, selecting the addition information for merging into the document from the server 104).

As claim 3, Van Hoff discloses a step of sending an additional content without altering from requested information (It's implicitly shown by Van Hoff because Van Hoff does not disclose a step of altering).

As claim 10-11 and 17-18, Van Hoff disclose an addition information comprising hyperlink to identify the additional content information (See Fig 4).

As claim 19, Van Hoff discloses a bridge server "Fig 2, Ref 118" for receiving a request for information of targeted server "Fig 2, Ref 104", determining if any addition contents are associated with the remote information server, then selecting an addition content to relay to the user (Fig 2, Ref 120) and adding the additional information into requested information to provide to the user (Fig 2, Ref 102; See col 4, lines 58 to col 6, lines 63).

As claims 20-21, Van Hoff discloses information being mark or tag by hyperlink such as URL to allow the user to retrieve the addition information (Fig 4).

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Haserolt as applied to claim 29 above, and further in view of Rondeau (USP 5850433).

As claim 30, Haserolt does not disclose the claimed invention. However, Rondeau disclosed a client system which transmits another request upon receiving an identifier of addition content from a server "Fig 1, Ref 28"; (a client clicks on the telephone icon to talk to the telephone 22 for addition content).

Since, Rondeau suggests a method of embedding the telephone number into a mark up page. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

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invention was made to apply a telephone number into a web page as addition content for allowing a user to contact with an agent for obtaining more information as disclosed by Rondeau into Harserolt's communication system. The motivation would have been to prevent the human error.

10. Claims 6-9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons/Van Hoff as applied to claims 1 and 19 above, and further in view of Rondeau (USP 5850433).

As claims 6-9 and 22, Simmons/Van Hoff fails to disclose the claim invention. Rondeau discloses the additional content information comprising an option to make a phone call by allowing a user to click on the icon (Fig 2, Ref 54) to make a phone call via the network to a PSTN handset (Fig 1, Ref 22) and the addition content such as telephone number must be marked by the access server for returning to the user in a form such as icon or button.

Since, Simmons suggests a method and apparatus for providing an advertisement via an Internet service provider. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a database server which includes a telephone icon as disclosed by Rondeau into a bulletin server's Simmons or server's Van Hoff. The motivation would have been to reduce the amount of time required to place a telephone to one of provider.

11. Claims 13-16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons/Van Hoff as applied to claims 1 and 19 above, and further in view of Haserodt (USP 6031836).

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As claims 13-16 and 23, Simmons/Van Hoff does not disclose the claimed invention. However, in the same field of endeavor, Haserodt a bridge server (Fig 1, Ref 104) for receiving a request for content which targets a network server (Fig 1, 105); the bridge server 104 marks up the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for receiving a request for content of a network server 105 from user 113; the server 104 generates a mark up request form for transmitting to the user 113; allowing the user 113 to resubmit the request the marked up content to server 104) for establishing a telephone call; See col 3, lines 55 to col 4, lines 60.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of marking up the request for transmitting to the client and allowing the client to resubmit the request as disclosed by Haserodt into Van Hoff's or Simmons' communication system. The motivation would have been to allow a client to contact with a agent in real time.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

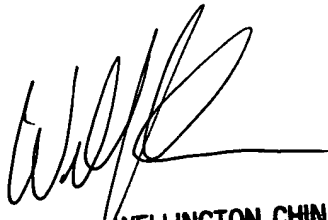
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

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The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2664
May 24, 2001



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